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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,303	11/10/2003	Satoshi Mizutani	20050/0200479-US0	5755

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EXAMINER

REICHLE, KARIN M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/706,303	Applicant(s) MIZUTANI ET AL.	
	Examiner Karin M. Reichle	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) 8, 10, 11, 15-17, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9, 12-14 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/20/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-20-06 has been entered.

Election/Restrictions

2. Claims 8, 10-11 and 15-17 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6-8-05. New claims 19-20 are also withdrawn since claim 19 claims a body facing adhesive which is not shown in the Figures of the elected species and Applicant has not set forth that such claims read on the elected species, see page 3, last full paragraph of the 5-11-05 election requirement.

Specification

3. The substitute specification, including the abstract, filed 4-20-06 has not been entered because it does not comply with 37 CFR 1.121, i.e. doesn't show all additions by underlining and all deletions struck thru, e.g. see marked up copy, e.g. line 1 of paragraph 1, paragraphs 2, 4, and 143, and paragraphs 80 and 134 which don't reflect changes to the text as previously amended.

The clean copy is also not clean, e.g. the paragraph numbers are underlined. Since the Figures as filed 11-8-05 are described by the not entered substitute specification these Figures have again not been approved.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

Drawings

5. The drawings were received on November 8, 2005. These drawings are still not approved by the Examiner, see the discussion supra.

6. The drawings are objected to because in Figures 2-4, the labels X-X, Y-Y and Z-Z should be avoided. Also the cross-sectional lines, e.g. in Figure 1, X-X, Y-Y and Z-Z, should be denoted by Roman or Arabic numerals, not letters. Figures 13A-D do not show a diagram as set forth on page 15. In Figures 1-6 and 8, the line from 8 should be dashed to denote underlying structure. In Figures 10-12, 8 should clearly denote the restriction, e.g. a line from the numeral thereto rather than a general arrow. In Figure 20, the lines from 38 and 39 should be arrows. Figure 31 should be labeled PRIOR ART. In Figure 27, the numeral 6 should clearly denote the cavity. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

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should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Description

7. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the abstract.

8. The abstract of the disclosure is objected to because the abstract should be limited to a single paragraph. Also terminology which can be inferred, e.g. "The present invention relates to", "according to the present invention", should be avoided. Correction is required. See MPEP § 608.01(b).

9. The disclosure is objected to because of the following informalities: The specification is replete with informalities. For example: 1) On page 3, line 9, "Disclosure of the Invention"

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should be --Summary of the Invention--. 2) On page 31, line 19, “21” should be --38--. 3) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims is not commensurate in scope, see MPEP 608.01(d). 4) On page 18, line 8, “Best Mode of Carrying Out the Invention” should be --Detailed Description of the Invention--. 5) The use of a confusing variety of terms for the same thing should be avoided. See MPEP 608.01(o). For example, see title and page 1, lines 13-15, i.e. “Package” or “wrapping body” and “wrapping container”? The specification should be carefully reviewed and revised, as necessary, to overcome all the informalities. Applicant is thanked in advance for the cooperation in placing the specification in proper form.

Appropriate correction is required.

Claim Objections

10. Claims 1, 3-7, 9, 12-14 and 18 are objected to because of the following informalities: In claim 1, line 9 is grammatically incorrect, i.e. should “covers across” be --extends from--? On line 12, “the” should be --a--. In claim 4, line 3, “the opposing” should be --an opposing--. In claim 6, line 2, “of” should be --between--. In claim 7, lines 2 and 3, after “at”, --a location which is--. On line 3, “form” should be --from--. In claim 9, line 3, “or” should be --of--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. Claims 4 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 4, it is unclear what structure is being claimed since the restriction portion as best understood is claimed at an end of the cavity where the cavity opening is not but the restriction is defined as being formed by bonding the cavity opening. In regard to claim 7, a positive structural antecedent basis for “the front end” (both occurrences) should be defined.

12. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 7 now requires a pad as claimed in claim 1 wherein the cavity opening is disposed a first specific distance from the front end of the pad and the finger restriction portion is disposed at a second specific distance from the front end. See Claim Language Interpretation section infra. While the original specification at page 8, lines 21-26 and the paragraph bridging pages 29-30 disclose a pad as claimed in claim 1 with ranges of first specific distances and ranges of second specific distances when in labial pads of certain ranges of length, this is not what is claimed. Where is a device as claimed in claim 1 in combination with such a first specific distance and such a second specific distance only disclosed in a single embodiment in the original application? For example, where does the original application disclose a pad of any length having an opening and restriction as claimed in claim 7 and that such configuration will

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stop the finger as set forth at Figure 8, page 4, lines 9-15, page 5, lines 1-6? If Applicant maintains such language the portion of the specification which provides support for the full scope of the claimed combination in a single embodiment should be set forth. See also the rejection of claim 7 *infra*.

Claim Language Interpretation

13. The claim terminology is interpreted in light of the specific definitions on page 5, lines 7-17. Any other claim language not specifically defined has been interpreted in view of the usual and common meaning of such, i.e. the dictionary definition. Lines 11-12 of claim 1 now require that the restriction at an end of the cavity is adapted to stop the finger at a position “corresponding” to the vagina. “Corresponding” as defined by the dictionary is “to be similar, parallel, equivalent or equal in character, quantity, origin, structure or function”. Since terminology is interpreted broadly, such terminology is interpreted as “similar” and “similar” is defined as “related in appearance or nature, alike though not identical”. Therefore, absent claiming of a specific position relative to the pad, the terminology “corresponding” is considered relative. While Applicant did not set forth the portion of the specification relied upon for support of the amendments to claim 1, lines 11-12, the specification is considered to provide support for such because it discloses a restriction is in the vicinity of the vagina at Figure 8, page 4, lines 9-15, page 5, lines 1-6, which as best understood disclose that the cavity has a restriction portion at an end thereof adapted to stop the finger at a point which point is such that a portion of the finger, i.e. the ball thereof, substantially corresponds, e.g. see Figure 8 of the application, to the position of a vagina of a wearer when the pad is appropriately applied, i.e. the point at which the

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finger is stopped does not correspond to the vagina but to a point which is rearward thereof. If Applicant is attempting to claim the point being equivalent or equal to, i.e. the same as, the position of vagina the specification does not appear to disclose such. It is noted that claim 1 does not require the restriction be at a longitudinal end of the cavity. It is also noted that the cavity is not claimed as being defined in the opposite face. Finally it is noted that the claims do not require the insertion of the finger in the cavity for applying the pad to the wearer. Also the specific dimensions of the terminology "mini" have not been set forth, i.e. "mini" only requires the sheet be smaller than some portion of the remainder of the pad. Due to the lack of clarity discussed supra, claim 4 will be interpreted as requiring the restriction portion being formed by bonding of a part of the opposite face. It is noted that claim 7 does not require any specifics of the front end of the pad, e.g. shape, dimensions with regard to the overall pad, etc. It is further noted that the terminology "front end" is not necessarily the front end edge. Note for instance the description at page 8, line 22 and page 9, line 16 of the original specification and original claim 7, i.e. "end" is not necessarily the same as "end edge" in light of the specification. It is also noted that the claim does not require the opening and restriction be only at such distance from the front end. Therefore, claim 7 is interpreted to require at least some portion of the cavity opening be at a location 40% from some portion of the pad which is in the front end, i.e. the front 50%, and that at least some portion of the restriction be at a location 90% from some portion of the pad which is in the front end, i.e. the front 50%. Also the terminology "by a predetermined distance" in claim 9 is considered relative absent the claiming of specifics thereof.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1, 3-7, 9, 12-14 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Chappell et al '566.

Claim 1: See Claim Language Interpretation section supra and '566 at Figures, paragraph 2, especially lines 9-10, paragraph 7, especially the last two sentences, paragraph 21 and paragraphs 30-35 i.e. the absorbent pad 10 has an elongate shape, a body facing side 12 and an opposite face, i.e. the outer face of 24, a cavity 38 for insertion of at least one finger formed along a opposite face in the longitudinal direction, a cavity opening, i.e. 38 adjacent axis Y-Y, a mini sheet 20 which extends from one lateral side of the pad to the other and is bonded to each. The cavity 38 includes a portion at an end thereof adjacent either 40 or 42 which is sealed closed, i.e. a restriction portion. Claim 1, lines 1, 5-6, 7-8, and 11-12 recite function, capability or property of the structure therein. Note again the Claim Language Interpretation section with regard to the terminology "corresponding". It is also noted that the claim does not set forth the position of the finger restriction portion relative to any specific points, positions or structure of the pad, i.e. a restriction portion anywhere on the opposite face which stops the finger is capable of stopping the finger at a position corresponding to the vagina depending on how the pad is positioned, nor the specifics of how the pad is positioned/used, i.e. the claim does not require

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such restriction portion to so position the finger relative to the vagina when the pad is applied at the correct point of wear as detected by the wearer with the ball of the finger so stopped through the pad. Therefore, and in light of the portions of Chappell cited supra, it is the Examiner's first position that the Chappell reference explicitly teaches such function, capability or property. In any case, i.e. the Examiner's second position, as noted supra the claim language recites functions, properties or capabilities of the structure set forth in claim 1. The Chappell reference at the very least teaches the structure of claim 1. Therefore there is sufficient factual evidence for one to conclude that such same structure of Chappell also inherently includes such claimed functions, properties and capabilities, see MPEP 2112.01. Note again the Claim Language Interpretation section supra especially with respect to the terminology "mini".

Claim 3: See the discussion of claim 1 supra and paragraph 21, i.e. adjacent either of the ends 40, 42 when the pad is oval shaped the cavity narrows gradually in width, or paragraph 34 and Figures 3-4, i.e. the cavity narrows gradually in height from the open end of 38 to the closed end along the Y-axis.

Claim 4: See Claim Language Interpretation section supra and paragraph 30, lines 5 et seq of '566, i.e. a portion of the opposite face is bonded to itself at an opposing side of the cavity, i.e. the upper side.

Claim 5: See discussion of claims 1 and 3 supra.

Claim 6: See Figures and paragraph 31.

Claim 7: See discussion in paragraphs 12 and 13 supra. See also last sentence of paragraph 31. The '566 device includes at least some portion of the cavity opening at a location 40% from some portion of the pad which is in the front end, i.e. the front 50%, and at least some

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portion of the restriction is at a location 90% from some portion of the pad which is in the front end, i.e. the front 50%.

Claim 9: See Claim Language Interpretation section supra especially with respect to the relative language and discussion of finger restrictions supra, i.e. absent claiming of specific distances relative to the ends and center, the Chappell reference is considered to teach the claimed structure.

Claims 12-14: These claims recite functions, properties or capabilities of the structure set forth in claim 1. If not already taught by the Chappell, see the portions cited supra, the Chappell reference at the very least teaches such structure of claim 1. Therefore there is sufficient factual evidence for one to conclude that such same structure of Chappell also inherently includes such claimed functions, properties and capabilities, see MPEP 2112.01.

Claim 18: See paragraph 31, i.e. can cover all of the section 32 or 34, i.e. 50%. It is noted Figure 2 of '566 shows the pocket 20 extending more than 50% of the length.

Response to Arguments


16. Applicant's remarks with respect to the informalities have been noted but are either deemed moot in that they have not been repeated or not persuasive for the reasons set forth supra. Applicant's remarks with respect to the prior art to Wierlacher have been considered but are deemed moot in that such rejection has not been repeated.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Karin M. Reichle
Primary Examiner
Art Unit 3761

KMR
June 12, 2006